

REMARKS

Claims 1-3 and 6-12 are pending in the application. Claims 3, 6 and 9-12 have been allowed.

Rejection of Claims under 35 U.S.C. § 112

Claims 1 and 7 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the recitation of “said predetermined sequence determined by a user of said portable telephone set” is not described in the specification. However, the specification states that there are five different retrieval modes, or predetermined sequences, available, and that the user selects one of the modes (page 6, line 28 to page 7, line 6). Thus applicant submits that this limitation is described in the specification. Therefore, this rejection should now be withdrawn.

Rejection of Claims 1 and 7 Under 35 U.S.C. §103

The Examiner has rejected claims 1 and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,408,191 to Blanchard et al. (hereinafter “Blanchard”) in view of U.S. Patent No. 6,320,943 to Borland and further in view of U.S. Patent No. 6,278,886 to Hwang. This rejection should be withdrawn based on the comments and remarks herein.

Blanchard is directed to an arrangement for displaying Short Message Services screens to portable telephone sets. The Examiner admits that Blanchard does not disclose that the data retrieved are displayed in a predetermined sequence with the total number of cases of the retrieved data. Additionally, Blanchard does not disclose a predetermined sequence determined by a user of the portable telephone set.

The shortcomings of Blanchard are not overcome by Borland. Borland is directed to a directory method and system for a communication device where caller ID is utilized for storage and retrieval. Borland teaches that a directory (such as in a PBX) may be accessed by a user to look up a specific person within a PBX exchange. Borland also teaches that a directory look up may be prioritized by the user of the telephone set. However, since the directory resides at the PBX exchange (rather than in a memory on the portable telephone set) the retrieved data is not retrieved "from a memory of the portable telephone set" as required by claim 1. Similarly, since the directory resides at the PBX exchange, there is no retrieval of the data stored in the memory of the portable telephone set as required by claim 7.

Hwang also does not overcome the shortcomings of Blanchard even hypothetically combined with Borland. Hwang is directed to a device and method for transmitting messages in a portable telephone (column 1, lines 8-9). Hwang teaches that the portable telephone inputs messages in a predetermined sequence and then transmits the input messages (column 2, lines 12-15). Hwang does not disclose or suggest "a predetermined sequence determined by a user of the portable telephone set" as recited in claims 1 and 7. Therefore, a hypothetical combination of Blanchard, Borland and Hwang does not teach or suggest every claimed feature of the present invention as recited in independent claims 1 and 7.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, even assuming that one could combine Blanchard, Borland and Hwang, this hypothetical combination does not teach or suggest every claimed feature of the present invention as recited in independent claims 1 and 7. Thus applicant requests that the rejection of claims 1 and 7 be withdrawn.

Rejection of Claims 2 and 8 Under 35 U.S.C. §103

The Examiner has rejected claims 2 and 8 under 35 U.S.C. §103(a) as being unpatentable over Blanchard in view of Borland in view of Hwang, and further in view of U.S. Patent No. 6,125,287 to Cushman. This rejection should be withdrawn based on the comments and remarks herein.

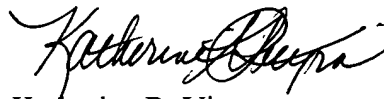
Claims 2 and 8 depend from independent claims 1 and 7, respectively, incorporating all of the features and limitations of the base claims. As discussed above, Blanchard, Borland and Hwang, even in combination, do not teach each and every claimed feature of these independent claims. Cushman does not overcome this deficiency. Cushman discloses a user interface for a portable telephone set, having a first directory containing frequently called numbers and a second or main directory containing alphabetically arranged entries (column 3, lines 56-59). Cushman does not disclose or suggest “a predetermined sequence determined by a user of the portable telephone set” as recited in claims 1 and 7. In addition, Cushman does not disclose or suggest displaying data with a serial number or number of times called, as recited in claims 1 and 7. Thus Cushman does not disclose or suggest displaying data “in the sequence of greater number of times of utilization *together with the serial number* of the retrieved data and the rearranged sequence” as recited in claims 2 and 8.

Therefore, a hypothetical combination of Blanchard, Borland, Hwang and Cushman does not teach or suggest every claimed feature of the present invention as recited in claims 2 and 8, as required for a finding of anticipation as discussed above. Accordingly, applicant requests that this rejection be withdrawn.

Conclusion

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable and respectfully requests that the Examiner reconsider the rejections and allow claims 1-3 and 6-12. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



Katherine R. Vieyra
Registration No. 47,155

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

KRV:kd